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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,123	01/29/2004	William A. Margiloff	E03.002/U	4363

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BUCKLEY, MASCHOFF & TALWALKAR LLC
50 LOCUST AVENUE
NEW CANAAN, CT 06840

EXAMINER	
AIRAPETIAN, MILA	
ART UNIT	**PAPER NUMBER**
3625	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/767,123	MARGILOFF ET AL.	
	Examiner	Art Unit	
	Mila Airapetian	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 January 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

Applicant's amendment received on 01/16/2007 is acknowledged and entered. The applicant has amended claims 1-7, 10-12 and 15. Currently, claims 1-15 are pending for examination.

Claim Rejections - 35 USC § 101

Claim Rejections - 35 USC § 101 has been withdrawn due to Applicant's amendment.

Claim Rejections - 35 USC § 112

Claim Rejections - 35 USC § 112 has been withdrawn due to Applicant's amendment.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 5-7, 10-12 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skillen et al. (US 6,098,065) in view of Rakavy et al. (US 5,913,040).

Claim 1. Skillen et al. (Skillen) teaches a computer-implemented method for providing advertisements to the users, comprising:

determining advertising information based on (i) contextual information associated with remote information being accessed by a user (col. 1, lines 39-49; col. 2, lines 35-39), and (ii) supplemental information associated with the user col. 3; lines 13-19); and providing for the determined advertising information to the user to be provided to the user (col. 1, lines 39-49).

However, Skillen does not teach that said determining advertising information includes locally determining at a user device.

Rakavy et al. (Rakavy) teaches a method for transmitting and displaying advertisement wherein advertisements are stored locally at a user device (hard disk) (col. 3, lines 22-26; col. 10, lines 22-23).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Skillen to include determining advertising information locally, as disclosed in Rakavy, because it would advantageously allow to present advertisements to the user in accordance with preconfigured user preference information (col. 3, lines 23-26).

Claim 2. Skillen teaches said method wherein the supplemental information is associated with at least one of: (i) geographic information, (ii) user device information, and (iii) other advertising information that has been provided to the user (col. 3, lines 13-19).

Claim 5. Skillen teaches said method wherein the contextual information comprises a key word (col. 4, lines 12-13).

System claims 6, 7 and 10 repeat the subject matter of method claims 1, 2 and 5 respectively, as a set of apparatus elements rather than a series of steps. As the underlying processes of claims 1, 2 and 5 have been shown to be fully disclosed by the teachings of Skillne in the above rejections of claims 1, 2 and 5, it is readily apparent that the system disclosed by Skillen includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 1, 2 and 5, and incorporated herein.

Claims 11, 12 and 15 are rejected on the same rationale as set forth above in Claims 1, 2 and 5.

Claims 3, 4, 8, 9, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Skillen and Rakavy, in view of Marsh et al. (US 6,876,974).

Claim 3. The combination of Skillen and Rakavy teaches all the limitations of claim 3 including providing the advertising information to the user device via a communication network (col. 3, lines 52-55). However, the Skillen and Rakavy does not teach that said advertising information is provided to the user when the user device is not communicating via the communication network.

Marsh et al. (Marsh) teaches a computer-implemented method for providing advertisements to the users wherein advertisements are presented to users during periods of off-line activity (col. 7, lines 1-2).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Skillen and Rakavy to include that advertising information is provided to the user when the user device is not communicating via the communication network, as disclosed in Marsh, because it would advantageously allow to avoid the downloaded during the on-line access advertisements become "stale", thereby avoiding the risk of users being numbed or otherwise negatively affected by their advertising as a result of overexposure, as specifically taught by Marsh (col. 2, lines 52-60).

Claim 4. The combination of Skillen and Rakavy teaches all the limitations of claim 4 except that said arranging comprises displaying a graphical advertisement to the user.

Marsh teaches said method wherein graphical advertisements are displayed to the user (col. 6, line 7).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Skillen and Rakavy to include that said advertisements include graphical advertisements, as disclosed in Marsh, because it would advantageously allow to recognize said advertisements instantaneously, thereby increasing efficiency of advertising.

System claims 8 and 9 repeat the subject matter of method claims 3 and 4 respectively, as a set of apparatus elements rather than a series of steps. As the underlying processes of claims 3 and 4 have been shown to be fully disclosed by the teachings of Skillne, Rakavy and Marsh in the above rejections of claims 3 and 4 it is readily apparent that the system disclosed by Skillen and Marsh includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 3 and 4 and incorporated herein.

Claims 13 and 14 are rejected on the same rationale as set forth above in Claims 3 and 4.

Response to Arguments

Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mila Airapetian whose telephone number is (571) 272-3202. The examiner can normally be reached on Monday-Friday 9:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on (571) 272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MA

MATTHEW S. GART
PRIMARY EXAMINER
TECHNOLOGY CENTER 3600